

APR 14 2010

HP Docket No. 10013014-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:09/992,666)
Conf. No.	:8495)
Appellant	:Blair et al.)
Filed	:11/19/2001)
Title	:Method and System For Gathering Data Using Automatic Appliance Feature)
TC / Art Unit	:3627)
Examiner	:Refai, Ramsey)
Docket No.	:10013014-1)
Customer No.	:022879)

Commissioner for Patents

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APPELLANTS' REPLY BRIEF

Sir:

This Reply Brief is presented in opposition to the Examiner's Answer mailed 02/23/2010. Appellants are appealing from the Final Rejection of claims 1-5 and 20-23.

I. ARGUMENT

The Examiner's Answer includes a "Response to Arguments" section at p.7-11. In that section, the Examiner identifies Arguments A through E in the Appeal Brief, and then presents responses to these arguments. The present section of the Reply Brief follows the structure used in the Examiner's Answer, and presents counterarguments to the specific responses presented by the Examiner.

However, it should be noted that Appellants do not necessarily agree with the

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Examiner's characterization in the Examiner's Answer of the various arguments presented by Appellants in the Appeal Brief. Instead, Appellants rely on the arguments presented in the Appeal Brief, and the supplemental arguments presented in the Reply Brief.

Initial Argument

The Examiner states, citing MPEP 2114, that "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" (Examiner's Answer, p.7).

Appellants disagree. To the extent, if any, that limitations in any apparatus claims are properly considered to be functional rather than structural ones, such limitations must be considered by the Examiner in making an obviousness rejection. Courts have held that functional limitations must be given patentable weight, even where it is only the functional limitations that distinguish over the prior art. See In re Land, 368 F.2d 866, 151 USPQ 621 (C.C.P.A. 1966); In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Argument A

The Examiner argues that the limitation of "for each of the printing devices, determining communication capabilities with the one or more appliances to determine communication paths between the plurality of printing devices and the one or more appliances" is taught by the alleged AAPA, para. [0003]-[0004] of U.S. published patent application 2003/009469, corresponding to Appellants' application (Examiner's Answer, p.7-8; emphasis added).

Appellants disagree. With regard to communications capabilities, the alleged AAPA teaches that "the operator typically relies on predetermined assumptions for determining which devices are capable of communicating with each other. For example, devices having similar addresses may be assumed to communicate with one another." Conversely, Appellants' claim 1 does not rely on predetermined assumptions, but rather the method determines these capabilities. As such, the alleged AAPA fails to teach or suggest at least

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these limitations of claim 1 in that claim 1 recites the opposite of what is disclosed by the alleged AAPA.

Argument B

Claim 1 recites “for each of the printing devices, determining communication capabilities with the one or more appliances to determine communication paths between the plurality of printing devices and the one or more appliances; transmitting signals indicative of the communication capabilities to the central controller; and mapping respective communication paths between the central controller and the printing devices via the one or more appliances as a function of the communication capabilities”.

The Examiner argues that the alleged AAPA teaches that “Mapping is performed for identifying which of the devices are capable of communicating with each other and certain devices are designated as data collection devices, all based on device information obtained during the monitoring process” (Examiner’s Answer, p.8-9).

Appellants disagree. The alleged AAPA fails to teach that any signals indicative of the communication capabilities with the appliances are transmitted to the central controller. The alleged AAPA teaches only that a mapping, somehow based on addresses, is provided from a human operator to the central controller.

Furthermore, there is no teaching that the communication paths are mapped as a function of the communications capabilities, as required by claim 1, in which the mapping element of the claim is performed using the transmitted signals of the prior claim element.

Thus the alleged AAPA fails to teach or suggest at least these limitations recited in claim 1.

Argument C

Claim 1 recites “mapping respective communication paths between the central controller and the printing devices via the one or more appliances ... to obtain an automatic appliance failover to allow diagnostic data to be collected from a selected printing device by way of multiple appliances”.

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The Examiner argues that “this limitation is merely a recitation of intended use. The claim is merely stating that the mapping step is done *to obtain an appliance failover to allow diagnostic data to be collected*. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim” (Examiner’s Answer, p.9; emphasis in original).

Appellants disagree. First, in contending that the intended use must result in a structural difference from the prior art in order to patentably distinguish, the Examiner appears to be making the same argument as the Initial Argument, which has already been traversed.

Second, Appellants disagree that mapping the paths to obtain an automatic appliance failover constitutes merely an intended use. To the contrary, it recites a characteristic of the resulting mapping that provides automatic appliance failover capability. Appellants’ specification explains that, “if any of the appliances 30 become disabled (e.g., go ‘down’), there is a high probability that the central controller 20 is capable of communicating with the devices 34 mapped to the disabled appliance via the other appliances. Such flexibility is referred to as automatic appliance failover” (specification, para. [0034]). This capability is achieved in Appellants’ invention in part through a technique in which, “if ... the device 34a is capable of communicating with the central controller 20 via two (2) of the appliances 30b, 30d, two communication paths are mapped between the central controller 20 and the device 34a in the block 106” (specification, para. [0029]). As such, the Examiner is required to give patentable weight to this limitation when considering the claim.

Third, the alleged AAPA fails to disclose any such automatic appliance failover. In fact, it discloses that such capability did not exist prior to the present invention: “Another drawback to the conventional process is evident when one or more of the data collection devices fails. In this case, the central controller cannot redirect a remaining one of the other data collection devices to gather the status data from the devices associated with the failed data collection device” (specification, para. [0007]).

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Thus the alleged AAPA fails to teach or suggest at least these limitations recited in claim 1.

Argument D

The Examiner contends that claim 1 as a whole is obvious over the alleged AAPA (Examiner's Answer, p.9-10). Appellants disagree.

The alleged AAPA, as discussed above, fails to disclose a method of configuring data communication paths between a central controller and a plurality of printing devices via a plurality of appliances that provides an automatic appliance failover. Moreover, as explained above with reference to Argument C, the alleged AAPA explicitly acknowledges the lack of such capability in prior systems (specification, para. [0007]). More particularly, the manual mapping information provided by the operator to the central controller is incapable of supporting automatic appliance failover, since "each of the devices" (i.e. printing devices) "is associated with one of the data collection devices" (i.e. the appliances), not with plural data collection devices (specification, para. [0004]; emphasis added).

To contend that a claim which explicitly recites the provision of an automatic appliance failover is obvious as a whole over cited art which does not - and cannot - provide an automatic appliance failover is clearly improper.

Argument E

Claim 1 recites the limitation of "ensuring one or more appliances of the plurality of appliances are active". While admitting that the cited art did not teach this limitation, the Examiner argued that "it would have been obvious to ensure that the devices are active prior to determining communications capabilities because doing so would allow for the mapping of devices to be properly obtained" (Final Rejection, p.9).

Appellants traversed the use of Official Notice, arguing that the recited operation is not capable of instant and unquestioned demonstration as being well-known, and is not so common as to defy dispute. In addition, the alleged AAPA teaches that it is not necessary because a human operator can manually obtain a mapping based on the addresses of the

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devices without the devices being active (Appeal Brief, p.13). Put another way, the alleged AAPA teaches away from the operation recited in the claim. At least for these reasons, the noticed fact is not to be considered common knowledge or well-known in the art.

In the Examiner's Answer, however, the Examiner does not discuss Official Notice with reference to this claim limitation at all. Instead, the Examiner takes the position that "the use of Official Notice ... was used only to reject the well known limitation, which is merely automatic appliance failover" (Examiner's Answer, p.10). Appellants fail to see the pertinence of this position to the claim limitation of "ensuring one or more appliances of the plurality of appliances are active" which is at issue. Moreover, for similar reasons as have been previously discussed with reference to Argument C, automatic appliance failover – assuming, arguendo only, that such would be capable of instant and unquestioned demonstration as being well-known and beyond dispute as asserted by the Examiner – cannot be implemented using the techniques taught by the alleged AAPA. Any operable combination can only be achieved through impermissible hindsight, using Appellants' claims as a blueprint or template for doing so.

II. CONCLUSION

Appellants contend that claims 1-5 and 20-23 were improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations, there is no articulated reason with some rational underpinning to modify or combine reference teachings, and/or there is no reasonable expectation of success in combining the references. Such a suggestion or motivation could be found only in hindsight and in light of Appellants' teachings.

Each of these reasons alone distinguishes Appellants' claims from the cited references and makes Appellants' claims non-obvious in light of the cited references.

Overruling of the Examiner's rejections of claims 1-5 and 20-23 is respectfully requested.

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Respectfully submitted,
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